



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 21415-0009

In re patent application of:

Bronwyn Jean BATTERSY *et al.*

Application No.: 09/856,859

Filed: September 6, 2001

Confirmation No.: 4713

Group Art Unit: 1639

Examiner: Maurie Garcia Baker

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For: CARRIERS FOR COMBINATORIAL COMPOUND LIBRARIES

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

This is in Response to the Office Action mailed November 13, 2002 (Paper No. 9), response to which has been extended to February 13, 2003, by filing a Petition for a two month Extension of Time and payment of appropriate government fees. Applicants do not believe that any additional fees are required. In the event this is not correct, applicants request such extension of time and authorize the Commissioner to charge the undersigned's Deposit Account No. 08-1641.

Applicants respectfully traverse the restriction requirement in the Office Action of November 13, 2002. The Examiner's lack of unity of invention determination is based upon Nova *et al.* (U.S. 5,751,629).

Applicants traverse this rejection because they believe such rejection to be based upon a misreading of claim 1. Specifically, the Examiners states that Nova teaches combinations, called matrices with memories, of matrix materials with remotely addressable or remotely programmable recording devices for use in combinatorial chemistry. The matrix of Nova *et al.* reads on the instant carrier. The memory of Nova *et al.* reads on the instant attributes that are detectable and/or quantifiable. Nova *et al.* specifically discloses electromagnetic tags in proximity to the matrix. The combinations of Nova comprise the matrix in physical contact with the memory in a covalent or non-

recording devices for use in combinatorial chemistry. The examiner then contends that Nova's matrix reads on applicants' carriers and that Nova's memory reads on applicants' attributes.

Turning to applicants' claims, applicants point out that each pending independent claim recites a carrier which has at least two attributes integrally associated therewith that are detectable and/or quantifiable. In contrast, the memory of Nova equates only to a single attribute. Thus, Nova has no adverse impact on the inventiveness of the claimed subject matter.

In view of the above explanations, applicants submit that the election requirement in this application is not proper and respectfully request for reconsideration and withdrawal of the requirement and examination of all claims. However, applicants provisionally elect, with traverse and without prejudice or disclaimer, the claims of Group II, claims 15-29, drawn to a plurality of carriers. In terms of an election of species, applicants elect:

1. at least 2 optically detectable and/or quantifiable attributes (see Examples 3 and 4);
2. attributes that are within or internally of the carrier (see example 3); and
3. carriers that have spherical shapes, are ceramic, about 4  $\mu\text{m}$  diameters and are  $\text{NH}_2$  functionalized (see examples 3 and 11).

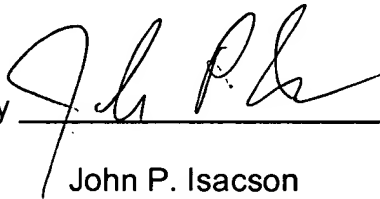
Applicants reserve the right to pursue non-elected subject matter in one or more divisional applications. Examination on the merits is awaited.

Respectfully submitted,

February 13, 2003

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